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| 10/595,697 | 05/05/2006 | Sandro Gerd Thronicke | SCH003-US | 4981 |

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| EXAMINER |
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WENDELL, MARK R

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3635

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09/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/595,697 | Applicant(s) THRONICKE ET AL. | |
| | Examiner MARK R. WENDELL | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070511</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 11-17 and 20-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10595695. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose and claim the same structure (see Figures) claimed in a slightly different way. The instant application does not claim a drainage layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Objections

Claim 1 is objected to because of the following informalities: The word "by" in line 2 should be deleted. Also, the language of lines 4-5 is a bit confusing and should be reworded. Perhaps the second occurrence of "that is" should be changed to "and is composed of." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "laid rigidly" is unclear and should be described further. It is unclear how an action can be rigid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5, 11-15 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siplast GMBH (EP0386324) in view of Nakazawa (US 5238721). Regarding claims 1 and 13, Siplast illustrates in Figures 1 and 2 a multilayer decoupling and sealing system with a sealing layer (3a) that is impermeable to liquid, characterized in that above the sealing layer (3a) that is composed of either a non-woven or woven fabric or a film, there is an anchoring layer (3b) formed from a lattice-type structural element for incorporating filler material (6) which is plastic when being applied and subsequently hardens within the anchoring layer. The examiner notes that the filler material and its properties are not positively claimed within the claim language. The filler material is nested in use language and the claim should be re-written if the applicant wants to indeed positively claim the structure. The reference, however, does not distinctly disclose a reinforcement layer being arranged above the anchoring layer. Nakazawa illustrates in Figures 1 and 3 a reinforcement layer (5) located directly below the ceramic tiles (6). The reinforcement layer of Nakazawa is used for elastic reinforcement of the tiles (see column 2, lines 30-62). The incorporation of the reinforcement layer would include the sheet being placed on top of the anchoring layer of Siplast and adhered to it via Siplast's filler material. It would have been obvious to one having ordinary skill in the art at the time of invention to include the reinforcement layer of Nakazawa on top of the anchoring layer of Siplast in order for a more elastic and secure connection of the tile to the underlying surface.

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Regarding claim 2, Siplast illustrates in Figure 1 the lattice-type structural element (3b) formed from individual rods that are disposed to one another in the manner of a lattice and fixed to one another at the points of intersection (see the overlap in Figure 1).

Regarding claim 3, Siplast in view of Nakazawa does not distinctly teach the rods being of rectangular cross-section; rather they teach the rods having a circular cross-section. It would have been obvious matter of design choice to modify the rods to have a rectangular cross section since the applicant has not disclosed that having the rods be rectangular in cross section solves any stated problem or yield any unpredictable results and it appears that the system would perform equally as well with the rods having a circular cross-section.

Regarding claim 4, Siplast illustrates in Figure 1 the intersecting rods of the structural elements are arranged so that a first layer consists of identically oriented rods (all facing left to right) beneath a second layer of individual rods disposed at an angle (90 degrees) to the first layer and or oriented in the same direction as one another (all facing vertically).

Regarding claim 5, Siplast illustrates in Figure 1 the lattice structure formed by the rods of 3b are in the form of a square, which by definition is also a rectangle and rhombus.

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Regarding claim 11, the invention of Siplast in view of Nakazawa has a reinforcing layer (5 of Nakazawa) cemented (via filler material 6 of Siplast) onto the anchoring layer (3b).

Regarding claims 12 and 21, Nakazawa describes in column 2, lines 37-62 the reinforcing layer being in the form of a lattice-type textile incorporated into the top of the sealing system. The examiner notes that the claim language “to provide for secure anchoring with the filler material” is functional language and is not given patentable weight (In re Fuller, 1929 C.D. 172; 388 O.G. 279). However, Nakazawa does recite this function in column 2.

Regarding claim 14, Nakazawa teaches throughout the specification the reinforcement layer (5) floating on the substratum in an elastic nature.

Regarding claim 15, Siplast illustrates in Figure 1 the sealing system being laid rigidly on the substratum (2). The examiner notes that the sealing system (3a) is laid on the substratum (2) and adhered thereto via an adhesive (1).

Regarding claim 22, Siplast teaches in column 1, line 1 – column 2, line 6, the sealing system being ventilated from behind.

Regarding claim 23, Siplast teaches in column 1, line 1 – column 2, line 6 the sealing system being a barrier element against moisture that is polystyrol.

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Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siplast GMBH (EP0386324) in view of Nakazawa (US 5238721) as applied to claim 1 above, and further in view of Barth et al. (US 6171015). It is described above what is disclosed by Siplast in view of Nakazawa; however regarding claims 6 and 10 the references do not distinctly disclose the individual rods being welded to one another or the reinforcing layer being welded to the anchoring layer. However, the references do show the layers being attached to one another and Barth teaches in column 3, lines 61-67, "as far as the joint between adjacent elements of the supporting structure is concerned, provision can also be eventually made here so that the elements are positively connected to one another by clamp-shaped parts, by adhesive bonding or by welding." Therefore it would be obvious to one of ordinary skill in the art to substitute adhesive bonding for a weld and to weld adjacent layers together for stability purposes for the entire structure.

Claims 7 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siplast GMBH (EP0386324) in view of Nakazawa (US 5238721) as applied to claim 1 above, and further in view of Nortene Technologies (FR 2774715). It is described above what is disclosed by Siplast in view of Nakazawa; however regarding claim 7 the references do not specifically disclose the individual rods having an undercut section. Nortene illustrates in Figure 1 the intersection of the rods having an undercut section. It would have been obvious to one having ordinary skill in the art at the time of invention

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to have the intersection of the rods have undercut sections for a more secure connection between the adjacent rods.

Regarding claim 16, Nortene discloses in claim 4 the sealing layer being formed from a polyethylene.

Regarding claim 17, Nortene teaches in the abstract that the sealing layer can be a non-woven material. The examiner notes that the language “for anchoring to the substratum” is functional language and is given no patentable weight. The sealing layer, being a non-woven material, can perform the function of anchoring to the substratum.

Regarding claim 18, Nortene teaches throughout the specification on Page 2 the sealing layer extending beyond the other layers.

Regarding claim 19, Nortene discloses in claim 4 the thickness of the anchoring layer being roughly between 2 and 6 mm. The examiner notes that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

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Regarding claim 20, Nortene discloses in claims 4-8 various thicknesses of the layers within the system adding to roughly between 2 and 8 mm. The examiner notes that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siplast GMBH (EP0386324) in view of Nakazawa (US 5238721) as applied to claim 1 above, and further in view of Lionel (US 6901712). It is described above what is disclosed by Siplast in view of Nakazawa; however regarding claims 8 and 9, the references do not disclose a continuous vapor pressure equalizing layer formed by polyethylene. Lionel teaches throughout the specification the use of a vapor pressure equalizing layer to keep moisture from penetrating through to an unwanted area (wall, tile, etc.). Lionel also teaches in column 5, lines 35-40 the layer being preferably polyethylene. It would have been obvious to one having ordinary skill in the art at the time of invention to include a vapor pressure equalizing layer within the structure (like that of Lionel) in order to keep moisture from penetrating into the upper tile or through the upper tile into the substratum.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is

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(571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/M. R. W./
Examiner, Art Unit 3635
September 9, 2008